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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/866,831

05/29/2001

Raymond Joseph Reisdorf

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05/18/2004

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LEGAL PATENT RECORDS CENTER
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WILMINGTON, DE 19805

EXAMINER

SALVATORE, LYND A

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,831

Applicant(s)

REISDORF ET AL.

Examiner

Lynda M Salvatore

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 4 and 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ETAILED ACTION

Response to Arguments

1. Applicant's response filed 02/17/04 has been fully considered and entered. Applicant's arguments regarding the 35 U.S.C 102(b)/103(a) inherency rejections set forth in sections 2-3 of the last Office Action are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 102/103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3,5,6, and 11-16 stand rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Caldwell, US 5,418,051.

Applicant argues that the instantly claimed stress index property is not inherent to the invention of Caldwell and since said property is not explicitly taught, Caldwell does not does qualify as prior art. Applicant further argues that the instantly claimed application does not mention silicone or fluorochemical as the first and second polymer materials. These arguments are not found persuasive. With regard to the lack of explicit teaching to the stress index, the Examiner asserts that this is the basis of inherency. The relied upon reference does not need to teach each and every performance limitation, if it can be shown that each and every chemical and/or structural limitation is met. Moreover, the prior art of Caldwell teaches the use of two different polymeric materials namely silicone and a top coat polymer comprising a dilute fluorochemical. As such, the Examiner maintains that the difference in stress indexes would not only be inherent, but because silicone is elastic it would naturally have a lower stress index than the top coat fluorochemical comprising polymer. The burden is shifted to Applicant to evidence

Art Unit: 1771

the contrary. Thus, since Caldwell meets each and every chemical and structural limitation set forth in the rejected claims especially in view of the fact that the instant claims are so broadly drafted so as to encompass every known and unknown polymer including the polymers taught by Caldwell, then it must meet the property limitations recited that depend from said claims. Where the Examiner has reason to believe a property asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, (s)he possesses the authority to require Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. *In re Swinehart*, 169 USPQ 226,229 Applicant should take this as the Office evocating its authority.

With regard to Applicant's argument that the instant application is not directed to the use of silicone or fluorochemical polymers, the Examiner acknowledges this point. However, while claims are interpreted in light of the specification it is improper to import limitations from the specification into the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant only discloses a variety of suitable polymers, but does not teach that the list is exhaustive (i.e., only those listed exhibit the desired stress index property) or does not preclude the use of other polymers such as those taught by Caldwell. Currently, it would be necessary for the skilled artisan to perform an experiment with every known polymer to determine infringement. The Office believes it is Applicant's duty to provide claims that are sufficiently specific so a determination of infringement can be made without undue experimentation *Ex parte Slob*, 157 USPQ 172

Art Unit: 1771

Additionally, while the Office recognizes a material of unknown structure can be claimed by a combination of physical and chemical characteristics *Ex parte Brian et al.*, 118 USPQ 242, a sufficient number of characteristics must be set forth so as to identify what was invented *Ex parte Siddiqui*, 156 USPQ 426; *Ex parte Davission*, 133 USPQ 400; *Ex parte Fox*, 128 USPQ 157. In the instant case, Applicant's sparse of number of characteristics fails to indentify anything to workers in the art. The rejected claims merely represent a desired outcome rather than the setting forth the limitations or characteristics to achieve the inventive entity.

Allowable Subject Matter

4. As previously set forth, claims 4 and 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, the prior art of Caldwell fails teach an ethylene methyl acylate first polymer and a second polymer selected from the group recited in claim 10. An updated art search did not produce any new substantial for which to base a rejection and presently no motivation exists to form an obvious type rejection.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1771

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 6, 2004

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SUPERVISORY PATENT EXAMINER
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